

Atty. Docket No. OPP031050US
Serial No: 10/722,299

Remarks

The present application has been restricted as follows:

Group I: Claims 1-3 and 9-18, drawn to a semiconductor device; and

Group II: Claims 4-8 and 19, drawn to a method of making a semiconductor device.

Applicant has elected, with traverse, Group I, Claims 1-3 and 9-18, drawn to a semiconductor device.

Restriction is proper only when the groups of claims are (A) independent or distinct as claimed, and (B) there is a serious burden on the Examiner (M.P.E.P. § 803). Claims are distinct when they are related as disclosed, but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (M.P.E.P. § 802.01; emphasis in original). Examiners must provide reasons and/or examples in support of their conclusions (M.P.E.P. § 803).

In this case, the burden of providing adequate reasons and/or examples in support of the conclusion of distinctness has not been met. As a result, the Restriction Requirement is improper, and should be withdrawn.

The conclusion that the claims of Groups I and II are distinct has been made. The reason and/or example has been provided that the semiconductor device as claimed (Group I) could be made by a materially different process in which the adhesive metal layer is not removed from the upper surface of the passivation layer. This reason and/or example is not an actual example of an alternative process for making the claimed device, nor is it an affirmative reason explaining why the claimed device is capable of separate manufacture. Rather, it is merely a statement of what the claimed process is not (i.e., the claimed process is not one in which the adhesive metal layer is not removed from the upper surface of the passivation layer). Thus, the reason and/or example provided is inadequate, and merely restates the premise of patentable distinctness as the conclusion for finding the same.

Atty. Docket No. OPP031050US
Serial No: 10/722,299

Furthermore, the reason and/or example provided does not appear to be reasonably plausible. It is not readily apparent to Applicant's undersigned representative how any functional and/or operational device could be made using the provided reason and/or example, as the provided reason and/or example does not state or explain how a device could actually be made that has an adhesive metal layer on an inner surface of a contact hole, exposing a metal wire layer, by a process that does not remove at least a portion of the adhesive metal layer from the upper surface of the passivation layer. While it might be possible, the reason and/or example provided contain no reasoning or explanation and cite no evidence to aid Applicant and Applicant's representative in understanding the reasoning behind the restriction requirement. Consequently, the reason and/or example given is inadequate to support of the conclusion of distinctness between Groups I and II above.

As a result, the burden of persuasion has not been met with regard to providing adequate reasons and/or examples in support of restriction between Groups I and II. Restriction would appear to be improper on this basis.

Conclusion

Applicant has elected, with traverse, Group I, Claims 1-3 and 9-18, drawn to a semiconductor device. However, in view of the inadequacy of the reason and/or example provided in support of the conclusion of distinctness between Groups I and II, the Restriction Requirement is improper and should be withdrawn. Thus, Claims 1-19 are in condition for further examination on the merits. Early notice to that effect is earnestly requested.

Atty. Docket No. OPP031050US
Serial No: 10/722,299

If it is deemed helpful or beneficial to the efficient prosecution of the present application, the Examiner is invited to contact Applicant's undersigned representative by telephone.

Respectfully submitted,



Andrew D. Fortney, Ph.D.
Reg. No. 34,600

7257 N. Maple Avenue, Bldg. D, #107
Fresno, California 93720
(559) 299 - 0128